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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,753	03/04/2004	Tsutomu Fujimura	249976US0	5264
22850	7590	11/23/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.			MCCORMICK EWOLDT, SUSAN BETH	
1940 DUKE STREET			ART UNIT	
ALEXANDRIA, VA 22314			PAPER NUMBER	

1655

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/791,753	FUJIMURA, TSUTOMU	
	<b>Examiner</b>	<b>Art Unit</b>	
	S. B. McCormick-Ewoldt	1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 1-3 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4 and 6-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The amendment of August 26, 2005 is hereby acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Applicant elected Group II and species *Schisandra chinensis*, filed on April 18, 2005.

### **Claims Pending**

Applicant has added claims 6-14. Claims 4 and 6-14 will be examined. Claims 1-3 and 5 are withdrawn.

### **Claim Rejections - 35 USC § 112**

Claims 4 and 6-14 are rejected under 35 U.S.C. 112, first paragraph, as stated previously in the prior Office action, because the specification does not reasonably provide enablement for preventing aging of the skin. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Undue experimentation would be required to practice the invention as claimed due to the quantity of experimentation necessary; limited amount of guidance and limited number of working examples in the specification; nature of the invention; state of the prior art; relative skill level of those in the art; predictability or unpredictability in the art; and breadth of the claims. *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Applicant maintains the word “preventing” in claim 4. Applicant’s claims are broadly drawn to preventing aging of the skin. The specification is not considered to enable this use. Applicant’s specification does not give any examples that show preventing aging of the skin. Applicant has not demonstrated inhibition or treatment of preventing aging of the skin. Applicant does not discuss the known means for preventing aging of the skin. “Preventing” aging of the skin requires prevention of each and every instances of aging. Such prevention is difficult, if not impossible, to achieve. Thus, Applicant does not provide enough information for a person of

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ordinary skill in the art to determine without undue experimentation that *Schisandra chinensis* is able to prevent aging of the skin.

Therefore, the rejection is deemed proper and is maintained.

Claim Rejections - 35 USC § 102

Claims 4 and 7-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Newmark *et al.* (US 6,242,012).

Newmark *et al.* (US 6,242,012) teaches using *Schisandra chinensis* on topically on the skin and improving skin tone. In addition, Newmark *et al.* teaches the amount of *Schisandra chinensis* in the amount of 2% (column 6, lines 42-43, 45-47; Table I; column 8, lines 18-21). However, Newmark *et al.* do not discuss the mechanisms of the claim but are inherent because the same composition is applied for the same purpose. Thus, Newmark *et al.* meet the limitations of claim 4 and thus anticipate the claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishibe (JP 2000178168 A).

Nishibe (JP 2000178168 A) teach that *Schisandra chinensis* is used in a composition for providing skin with elasticity, improving the aging of the skin and reducing wrinkles. However, Nishibe does not discuss the mechanisms of the claim but are inherent because the same composition is applied for the same purpose. In addition, Nishibe does not disclose the amount of agent applied to the skin.

The references also do not specifically teach the amount of the agent to be applied to the skin as claimed by Applicant. The amount of a specific ingredient in a composition is clearly a

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result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of Applicant's invention.

Claims 4 and 6-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newmark *et al.* (US 6,242,012).

Newmark *et al.* (US 6,242,012) discloses using *Schisandra chinensis* topically on the skin and improving skin tone. In addition, Newmark *et al.* teaches the amount of *Schisandra chinensis* in the amount of 2% (column 6, lines 42-43, 45-47; Table I; column 8, lines 18-21). However, Newmark *et al.* do not discuss the mechanisms of the claim but are inherent because the same composition is applied for the same purpose.

The references also do not specifically teach the amount of the agent to be applied to the skin as claimed by Applicant. The amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient in order to best achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, this optimization of ingredient amount would have been obvious at the time of Applicant's invention.

#### Summary

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Susan B. McCormick-Ewoldt whose telephone number is (571) 272-0981. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (571) 272-0974. The official fax number for the group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sbme

*Susan D. Coe*  
11-7-05  
**SUSAN COE**  
**PRIMARY EXAMINER**